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| MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201 | | | NGUYEN, TAM M | |
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/042,248

Filing Date: January 11, 2002

Appellant(s): RAGIL ET AL.

Slavik Kasztelan
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 8, 2008 appealing from the Office action mailed January 3, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,982,048 STEM et al. 1-1991

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 6, 7, 12-25, 29-34, 38, 39, and 42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains

subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "wherein the feed is a fresh feed not previously treated as to separated di-branched and tri-branched paraffins therefrom" in claims 6, 38, and 39 was not described in the specification at the time the application was filed.

Claims 6-9, 11-26, and 29-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stem et al. (US 4,982,048).

Stem discloses an isomerization to produce components for gasoline pool. The process comprises passing a hydrocarbon feed comprising C₆₊ including C₇ and C₅ components into an isomerization zone to produce a mixture comprising multi-branched paraffins (e.g., di and tri-branched paraffins), mono-branched paraffin, and normal paraffin. The mixture is then passed into a separation zone to produce a multi-branched paraffinic (e.g., di and tri-branched paraffins) stream, a mono-branched paraffin stream, and normal paraffin stream. Stem also teaches that the process may comprise two separated isomerization zones with the normal paraffins being isomerized in the first zone and the mono-methyl paraffins being isomerized in the second zone. The isomerization process is operated at temperatures ranging from 200° to 400° C and at pressures ranging from 10-40 bars (1 to 4 Mpa). The isomerization process is operated in the presence of hydrogen and catalyst. It is noted that Stem does not disclose that the isomerization feed comprises multi-branched paraffins. However, there no separation is 100% effective. Therefore, it would be expected that the isomerization feed from the upstream separation zone would comprises at least some small amount of multi-branched paraffins. (See col. 3, line 55

through col. 4, line 57; col. 9, lines 14-53, and 68; column 10, lines 1-15; column 11, lines 46-68; column 12, lines 1-22; col. 17, lines 9-33; and Figures 2-7)

Stem does not specifically disclose that the multi-branched paraffin stream provides a minimum content of 2 % weight of C₇ di-branched paraffins, does not disclose the locations and the zones as in claim 9, and does not disclose that the feed is a fresh feed not previously treated as to separated di-branched and tri-branched paraffins therefrom

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of Stem by using a feed comprising the claimed amount of C₇ paraffins because Stem teaches that the feedstock can comprise quantities of C₇ paraffins (see col. 5, lines 57-62). Therefore, one of skill in the art would utilize a feedstock comprising any amount of C₇ paraffins including the claimed amount with the expectation that a feedstock comprising any amount of C₇ paraffins would be effectively processed in the process of Stem. As a result, it would be expected the product stream would comprise at least 2 wt. % of C₇ di-branched paraffins.

Deleted:

It also would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of Stem by locating the zones as in claim 9 because the process of Stem is a cyclic process and the locations of the zones would not affect the outcome of the process since the feed is ultimately passed through each zone.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of Stem by omitting the pre-treating step when fresh feed comprised primary n-paraffins is used.

(10) Response to Argument

All appealed claims are rejected under 35 U.S.C 103(a) and there are no new-grounds of rejection in this Examiner's Answer.

The argument that the present application will reasonably convey to one of skill in the art the concept that the feed is fresh not previously treated is not persuasive. The present application as a whole does not suggest or disclose that the feed has not been previously treated. Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984).

The argument that from the figures and throughout the specification it is clear that the feed is a fresh feed not previously treated so as to separate di-branched and tri-branched paraffins therefrom is not persuasive. Nowhere in the specification discloses that the feed is “a fresh feed not previously treated so as to separate di-branched and tri-branched paraffins”. A feed comprising multi-branched paraffins does not necessarily imply that the feed has not been previously treated to separate multi-branched paraffins therefrom. For example, if only a certain amount of di-branched and tri-branched paraffins is desired in a feedstock, a separating step would be employed to remove multi-branched (extra di-branched and tri-branched) paraffins from the feedstock, which would still comprise di-branched and tri-branched paraffins. Furthermore, on page 11 of the present specification, it is stated that the feed is originated from an atmospheric distillation. This atmospheric distillation step could be considered as a pre-treating step.

Regarding to the argument about the Declaration filed on October 16, 2006, the argument is found not persuasive. From pages 12 and 13 of the present specification, it is not clear that if the feed has not been pre-treated. For example, on page 11, it is state that the feed is originated from atmospheric distillation. This atmospheric distillation step can be a pre-treating step.

The argument that the teaching of Stem are directly contrary to the claimed invention which recited that the fresh is not previously treated to separate di-branched and tri-branched paraffins therefrom and it is no possible reason to modify Stem to eliminate the separation zone (pre-treating step) is not persuasive. Stem primary purpose is to isomerize only the normal paraffins. One of skill in the art would omit the pre-treating step when a feed comprises primary normal paraffins and only a very small amount of multi-branch paraffins.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

tn
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